

Decision for dispute CAC-UDRP-105857

Case number	CAC-UDRP-105857
Time of filing	2023-10-09 09:55:51
Domain names	bouygues-batiments--ile-de-france.com

Case administrator

Name	Olga Dvořáková (Case admin)
------	-----------------------------

Complainant

Organization	BOUYGUES
--------------	----------

Complainant representative

Organization	NAMESHIELD S.A.S.
--------------	-------------------

Respondent

Organization	GOBERT CHRISTIAN
--------------	------------------

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademark registrations for the sign “BOUYGUES” (the “BOUYGUES trademark”): the International trademark BOUYGUES with registration No. 390771, registered on 1 September 1972 for goods and services in International Classes 6, 19, 37 and 42; and the French trademark BOUYGUES with registration No. 1197244, registered on 4 March 1972 for goods and services in International Classes 6, 16, 19, 28, 35, 37, 40, 41, 42, 43, 44 and 45.

FACTUAL BACKGROUND

The Complainant was founded in 1952. It is a diversified group of industrial companies in the sectors of construction, telecoms and media, which operate in more than 80 countries. The net profit of the group for 2022 amounted to EUR 973 million. The Complainant through a subsidiary is the owner of the domain name <bouygues.com>, registered on 31 December 1999. The Respondent registered the disputed domain name on 27 August 2023. It resolves to a parking webpage.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS: COMPLAINANT:The Complainant submits that the disputed domain name is confusingly similar to the Complainant's distinctive and well-known BOUYGUES trademark, because it reproduces the trademark in its entirety. The addition of the French dictionary word "bâtiments" and the French geographic indication "Île-de-France" is not sufficient to change the overall impression of the disputed domain name as being connected to the Complainant's BOUYGUES trademark and does not prevent the likelihood of confusion between them. According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant submits that it has never authorized the Respondent to use the BOUYGUES trademark, the Respondent is not commonly known by the disputed domain name and is not using or planning to use it, except in order to create a likelihood of confusion with the Complainant and its trademark. The disputed domain name resolves to a parking page. The Complainant contends that the disputed domain name was registered and is being used in bad faith. It points out that the BOUYGUES trademark is distinctive and well known, so the Respondent must have registered the disputed domain name with knowledge of this trademark. The Complainant submits that the disputed domain name resolves to a parking page, and it is not possible to conceive of any plausible actual or contemplated active use of it by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law. **RESPONDENT:**The Respondent did not submit a Response in this proceeding.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in respect of the domain name; and (iii) the respondent has registered and is using the domain name in bad faith. In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case. By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name ..." In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not filed a Response addressing the contentions of the Complainant and the evidence submitted by it. **Identical or confusingly similar** The Complainant has provided evidence and has thus established its rights in the BOUYGUES trademark. The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain ("gTLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com" gTLD section of the disputed domain name. The relevant part of each of the disputed domain names is therefore the sequence "bouygues-batiments-ile-de-france", which reproduces the BOUYGUES trademark in its entirety together with a simplified spellings of the French dictionary word "bâtiments" (meaning "buildings" or "properties" in English) and of the French geographic indication "Île-de-France" (the French region in which the city of Paris is located). As discussed in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. In view of the above, the Panel finds that the disputed domain name is confusingly similar to the BOUYGUES trademark in which the Complainant has rights. **Rights and legitimate interests** While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a

domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because it was not authorized to use the BOUYGUES trademark and is not commonly known under the disputed domain name. The Complainant also points out that the disputed domain name resolves to a parking webpage. Thus, the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not submitted a Response and has not provided any explanation of its actions related to the disputed domain name. In the Panel’s view, the circumstances of this case support the *prima facie* case made by the Complainant. The disputed domain name is confusingly similar to the BOUYGUES trademark and includes additional terms related to the construction business of the Complainant and the name of the geographical region in France where Paris is located. It resolves to a blank webpage. In the lack of any arguments or evidence to the contrary, the above leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant’s BOUYGUES trademark, has registered the disputed domain name targeting this trademark in an attempt to exploit its goodwill by confusing and attracting Internet users who may believe that the disputed domain name is related to the Complainant’s construction business in Paris and the region around it. The Panel does not regard such activity as giving rise to rights or legitimate interests of the Respondent in the disputed domain name. Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain names. **Bad faith** Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely: “(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.” The disputed domain name resolves to a blank webpage. Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this dispute. While panellists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. WIPO Overview 3.0, section 3.3. The registration of the distinctive BOUYGUES trademark predates the registration date of the disputed domain name with decades. As discussed above in this decision, the Respondent has failed to submit a Response or to provide any evidence of actual or contemplated good-faith use of the disputed domain name, and its composition may lead Internet users to believe that it is related to the Complainant’s construction business in Paris and the region around it. In the lack of any plausible explanation by the Respondent how the disputed domain name may be put to a legitimate use, the Panel accepts as more likely than not that the Respondent has registered the disputed domain name with knowledge of the Complainant’s BOUYGUES trademark and with the intention of taking advantage of its goodwill to attract Internet users for commercial gain by creating a likelihood of confusion with this trademark. Taking all the above into account, the Panel therefore finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

- 1. bouygues-batiments--ile-de-france.com: Transferred

PANELLISTS

Name	Assen Alexiev
------	---------------

DATE OF PANEL DECISION 2023-11-02

Publish the Decision